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PATENT APPLICATION
Docket No.: 4098.2.1A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael Hamilton et al.
Serial No.: 09/521,152
Filed: March 8, 2000
For: MESSAGE ROUTING
Examiner: Marlon B. Johnson (Art Unit 2153)
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INTERVIEW SUMMARY & RESPONSE

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Commissioner:

In response to the Office Action mailed January 7, 2003, Applicants respectfully submit the following remarks and request favorable reconsideration of this application.

Information Disclosure Statements

The undersigned thanks the Office for providing initialed forms PTO-1449 acknowledging that the Examiner received and reviewed each reference in each of the first six Information Disclosure Statements. A Seventh IDS, which was filed December 3, 2002, has not yet been acknowledged by the Office. An Eighth IDS is filed concurrently with this Response.

Interview Summary

The undersigned thanks Examiner Johnson for the correction provided by phone on February 11, 2003. The Examiner stated that the Office Action citation(s) to "Joy et al." (see the bottom of page 4) were intended by the Examiner to be citations to "Low et al.", which is U.S. Patent No. 6466570. The Examiner stated he did not intend to cite any Joy patent. The present Response was prepared with that correction in mind.

Hyperlinks in Specification

The Office Action objects to the use of "embedded hyperlink and/or other form of browser-executable code" in the application, and cites MPEP § 608.01. The undersigned

1.511

was not previously aware of Office policy against the inclusion of hyperlinks in applications, and thanks the Examiner for pointing out this policy. Three hyperlinks were identified in the Office Action; the undersigned found a fourth hyperlink on page 4 line 19 of the application by searching for "http". The undersigned is unsure what the Office Action meant by "other form of browser-executable code", and asks the Office to identify that offending material – if any – so that Applicants can respond appropriately.

None of the four hyperlinks was meant to incorporate subject matter by reference to satisfy 35 U.S.C. § 112, and none of them was meant to be an active link in online copies of the application or any resulting patent. However, they were meant to assist readers in finding background information. Accordingly, the undersigned is reluctant to simply delete them.

With the Office's permission, the hyperlinks will therefore be amended so that they cannot function as active links but can still guide readers to the web sites in question. This could be done in various ways, but one that may be acceptable to the Office is to split the address into parts and tell readers how to reconstitute it. Of course, readers would also need to be told that this had been done, and why.

Accordingly, the undersigned proposes to amend the specification at page 2 line 10 by replacing:

A messaging service which is advertised and described at <http://www.jfax.com> apparently operates as follows.

with:

A messaging service which is advertised and described at a jfax web site apparently operates as follows. (Because USPTO policy prohibits inclusion of hyperlinks in patents, the jfax web site address is not stated expressly here. However, the jfax web site address can be produced by typing "www" followed by a period followed by "jfax" followed by a period followed by "com".)

Similar amendments would be made to handle the other hyperlinks. If this approach is acceptable to the Office, please so indicate, and an appropriate amendment will be filed. If this approach is not acceptable to the Office, please explain why not, and please suggest alternatives.

Drawings

The Office Action objects to aspects of the drawings. A proposed drawing correction is enclosed. As shown, the proposed correction makes the following changes:

1. In Figure 2A, "TO LIVE RECEPIENT 272" becomes "TO LIVE RECIPIENT" and "TO PAGER 280" becomes "TO PAGER".
2. In Figure 3, reference numerals 318, 334, 336 are deleted; the accompanying text and components identified by that text are not deleted.

If this drawing correction is acceptable to the Office, please so indicate, and formal amended drawings will be filed by Applicants. If this drawing correction is not acceptable to the Office, please explain why not, and suggest alternatives.

The drawings were also objected to because they do not contain message step 288. The Examiner is correct that the reference on page 22 line 15 should be to step 282. The Examiner may make this change by an Examiner's Amendment; if that is not acceptable then Applicants will request correction in their next communication to the Office.

Office Action Generally

The Office Action is organized, detailed, and lengthy. It is clear that the Examiner spent significant time and effort studying the claims and the references. The undersigned thanks the Examiner and the Office for providing such a detailed Office Action, which helps narrow the issues for discussion.

Official Notice

In the Office Action, official notice of various items is asserted in connection with the following claims: 3, 5, 6, 8, 9, 10, 11, 12, 13, 20, 21, 22, 24, 26, 28, 29, 35, 36, 39, 40, 42, 43, 47, 52, 53, 55, 56, 57, 58, 59, 60, 61, 68, 69, 71, 72, 73, 74, 75, 76, 77, 83, 85, 86, 87.

Pursuant to M.P.E.P. § 2144.03, Applicants hereby challenge the official notice with regard to each of the following claims: 3, 5, 13, 42, 43, 47, 56, 57, 58, 75, 76. With regard to each of these claims, Applicants respectfully ask the Examiner to either provide documentary evidence in the next Office Action supporting the official notice (as discussed in M.P.E.P. § 2144.03), or else to withdraw the rejection of that claim. Applicants do not presently challenge the official notice that was taken with regard to the claims not listed in this paragraph.

Combinations Relied On for Rejections Made Under 35 U.S.C. § 103

All claim rejections made in the Office Action are made under 35 U.S.C. § 103, in reliance on combinations of references and/or other assertions of official notice. To properly support an obviousness rejection under section 103, it is **not enough to merely find all claimed limitations somewhere in the prior art**. The Office must also show that the references and/or the instances of official notice were properly combined with each other. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 221 USPQ 929,933 (Fed. Cir. 1984). One "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988).

To support a holding of obviousness, there must be specific evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). As the Federal Circuit stated: "Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." Ecolchem Inc. v. Southern California Edison, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

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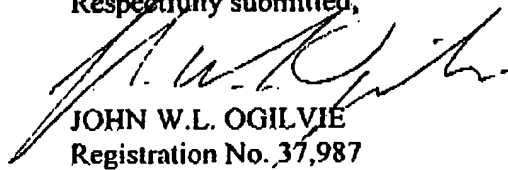
The Office Action fails to provide evidence of a motivation or suggestion to justify combining the three cited patents (Agraharm, Low, Nicholls). The Office Action also fails to provide evidence of a motivation or suggestion to justify combining officially noticed "facts" with any or all of those three patents. Without a showing of specific evidence in the prior art that supports the combinations relied on to reject the claims, the rejections are not proper and they should be withdrawn.

Conclusion

Applicants respectfully request favorable reconsideration of the application. This response was prepared with a goal of reaching consensus on points for which agreement is likely (e.g., amendments re hyperlinks and drawings), and with a goal of identifying for the Office the dispositive lack of a motivation or suggestion to combine, which makes every rejection improper. Applicants reserve the right to make other arguments and present other evidence or amendments later.

If there are any questions that might be answered by telephone, the undersigned is available at the Examiner's convenience. Regardless, Applicants and the undersigned respectfully await the next communication from the Office.

Respectfully submitted,


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